

### **REMARKS**

Claims 1-15 and 21-25 were pending and rejected. In this response, Applicants have amended claims 1-15 and 21-25 and added new claims 26-31. Claim 16 was previously cancelled, and claims 17-20 are currently cancelled without prejudice. Therefore, claims 1-15 and 21-31 are currently pending. The amendments and new claims are fully supported by the disclosure and no new matter has been added. Applicants respectfully request reconsideration and allowance in light of the amendments to the claims and the following remarks.

### **Double Patenting**

In the Action, claims 1-15 and 21-25 were provisionally rejected for nonstatutory obviousness-type double patenting over claims 1-14 of copending Application No. 10/552873, and rejected for nonstatutory obviousness-type double patenting over claims 1-22 of U.S. Patent No. 7,490,641.

Applicants attach to this communication terminal disclaimers under 37 C.F.R. § 1.321(c) for copending Application No. 10/552873 and for U.S. Patent No. 7,490,641. Applicants respectfully submit that the terminal disclaimers obviate the double patenting rejections.

### **Objections to the Specification**

The amendment filed July 20, 2009 was objected to under 35 U.S.C. 132(a) on the grounds that it introduced new matter into the disclosure by amending claims 1 and 24 to recite "processing machine." The Examiner noted that the original disclosure supports structure including a planer, planer-matcher, or moulder. Applicants note that the disclosure further supports an optimizing planer (see e.g. Figures 29-32 and page 33, lines 9-16 of the specification).

Amendments to an application which are supported by the original description are not new matter (see e.g. MPEP 2163.07). While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification

through express, implicit, or inherent disclosure (MPEP 2163). "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." MPEP 2144.01, citing *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

While Applicants respectfully maintain that the term "processing machine" is supported by the original disclosure, Applicants have nonetheless amended claims 1 and 24 to clarify that these claims are directed to infeed systems for feeding an array of workpieces linearly downstream to a processing machine with at least one or more movable cutting elements or movable guiding elements. Applicants respectfully submit that the disclosure of a planer, optimizing planer, planer-matcher, and moulder provides support for "a processing machine" as claimed (see e.g. pg. 1, lines 11-13). Thus, the term "processing machine" does not introduce new matter, and Applicants respectfully request that the objection be withdrawn.

#### **Claim Rejections – 35 U.S.C. §112, First Paragraph**

Claims 1-15 and 21-25 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with both the written description requirement and the enablement requirement. Specifically, the Office Action cited a lack of support in the original disclosure for "a processing machine."

The subject matter of the claim need not be described using the same terms in order for the disclosure to satisfy the description requirement (see e.g. MPEP 2163.02). Further, "not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991), MPEP 2164.08. The specification must teach those skilled in the art how to make and use the full scope of the claimed invention "without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993), MPEP 2164.08.

“Processing machine” is fully supported in the original disclosure because Applicants disclose several machines “widely used . . . to turn rough workpieces into finished workpieces such as surfaced lumber and contoured shapes like molding, flooring and siding” (pg. 1, lines 11-13). While the Examiner asserts that processing machines in the woodworking art may be planers, jointers, or other various machines, Applicants respectfully submit that such machines are well known in the art. Therefore, the disclosure of every possible “processing machine with at least one or more movable cutting elements or movable guiding elements” is not required. A person having ordinary skill in the art would be enabled by the Applicants’ disclosure to make and use the entire scope of the claimed invention without undue experimentation.

For at least these reasons, claims 1-15 and 21-25 comply with the written description requirement. Reconsideration of these rejections is respectfully requested.

#### **Claim Rejections – 35 U.S.C. §112, Second Paragraph**

Claims 1-15 and 21-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In response, Applicants have amended the claim language specified in the rejections under this paragraph to overcome all rejections under 35 U.S.C. 112, second paragraph. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **New Claims**

Applicants take this opportunity to add claims 26-31. Claims 26-31 are fully supported by the disclosure and no new matter is added. Support for claim 26 is found in the specification and figures at least as indicated below in bold. New claim 26 recites an infeed system comprising:

an infeed conveyor describing a path of workpiece flow, the infeed conveyor configured to transport a first and a second workpiece sequentially downstream along said path; **(Figs. 3-8, 26, 28; paragraphs [0021], [0096]-[0097])**

an acceleration device coupled to the infeed conveyor and configured to adjust the velocity of the first and the second workpieces along said path; **(Figs. 3-22; paragraphs [0022], [0072], [0078]-[0093])**

a variable speed drive coupled to the acceleration device and configured to control the acceleration device; **(Figs. 3-5, 8, 26, 28; paragraphs [0096], [0097], [0117]-[0119])**

a workpiece sensor coupled to the infeed conveyor and configured to generate data corresponding to one or more attributes of the first and the second workpiece; **(Figs. 3-8, 26, 28; paragraphs [0064], [0073], [0093])** and

a control system coupled to the workpiece sensor and the variable speed drive, the control system configured to **(Figs. 3-8, 26, 28; paragraphs [0014], [0023], [0062], [0065]-[0067], [0072], [0089], [0095]-[0097])**

receive said data from the workpiece sensor,

determine a desired gap between the first and second workpieces on said infeed conveyor based at least in part on said data, and

send an instruction to the variable speed drive, the instruction comprising a command for adjusting operation of the acceleration device, wherein adjusting operation of the acceleration device adjusts the distance between the first and second workpieces to create the desired gap. **(Figs. 2, 29-32; paragraphs [0017]-[0018], [0072], [0096]-[0097])**

Applicants note that new claim 26 recites features substantially similar to those of independent claim 1, but without the means plus function language of claim 1. Therefore, claim 26 is also allowable over the references previously cited against claim 1 for at least the same reasons discussed by Applicants in their response filed July 20, 2009. New claims 27-31 depend from claim 26 and incorporate its recitations, and are

thus allowable by virtue of their dependence from an allowable base claim as well as for their additional recitations.

Applicants respectfully submit that all currently pending claims are allowable as amended and/or currently presented. Notice of Allowance is therefore requested.

### **CONCLUSION**

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance. Should any questions arise, the Examiner is invited to contact the undersigned at (503) 796-2456. Also, the Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: February 16, 2010

/Christopher J. Lewis/  
Christopher J. Lewis  
Reg. No. 51246

Pacwest Center, Suite 1900  
1211 SW Fifth Avenue  
Portland, Oregon 97204  
Telephone: (503)222-9981